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Remark:

First of all, the examiner is respectfully requested to review the amended subject claims and new claim 52, which helped the subject invention to further define over Spackova and Asalka. The process of claim 52 is fully disclosed in the specification and therefore not a new matter. Claims 3-4, 25-27, 29-31, 42-47 are amended to conform to the latest amendment of claim 40. These claims are withdrawn after amendment to comply with the election requirement.

Claims 1, 6-18, 40 and 49 were rejected under 35 U.S.C. 103(a) as unpatentable over Spackova et al. in view of Powell.

Independent claim 40:

Listed below are the three limitations recited by claim 40:

- (1) defining m different physical dimensional parameters of said human body;
- (2) measuring each of said m defined parameters a physical dimension of said body to produce m values; and
- (3) processing said m values to produce a multiple digits compressed BP code for representing said m values.

According to the telephone interview with the examiner dated 10/30/2007 (please refer to the interview summary dated 10/30/2007 and applicant's response dated 10/31/2007) the examiner agreed that Spackova did not explicitly disclose the step to define m different physical dimensional parameters. Spackova did not explicitly disclose the names of the parameters defined. Spackova also did not explicitly disclose a step to measure the m parameters of the body. However, the systems of Spackova allows a person to define two or more different parameters (e.g. distances between 72, 74 and 72, 75 of FIG. 3 is desired). The systems of Spackova allows people to assign names to each of the distances 72, 74 and 72, 75. The system of Spackova also allows the distances 72, 74 and 72, 75 to be measured. It seems after reconsidered the latest response from the applicant dated 10/31/2007, the examiner is not convinced that Spackova did not disclose the above three characteristics enlisted above, because the system of Spackova is capable to perform the three claimed characteristics if required.

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After carefully reconsidering the position of the office action dated 01/07/2008, the examiner is respectfully directed to pay attention to a significant error how the process of examination is conducted. Claim 40 is a method claim that claimed "specific steps of action, each treated as a limitation". The disclosure of Spackova is about an utility system. The position of the examiner is that the claimed steps can be performed by the utility system of Spackova if required. There are two significant errors [marked as (A) and (B) below] noticed on this approach of examination:

(A) The reason of rejection is based on subject matter of different nature

As compared with utility claims, method claims claimed steps of actions. It is a technical error to use a system description to support rejection where a claim limitation is an action step by itself. The reason is very simple; step of action and a system description are subject matters of completely different nature.

When this is clear, then let us compare the claim limitation of step (1): "an action step to define *m* different physical dimensional parameters of a human body". According to the subject specification, this defining step is the real action step to "name" different body positions as the physical dimensional parameters such as inseam, neck circumference etc., and specifying the positions for these parameters to be measured, so as for these parameters to be measured by a later action step. While the examiner agreed that Spackova did not explicitly disclosed the "action" of defining the parameters, the examiner's rejection was based on the point that the systems of Spackova allows people to assign names to each of the distances 72, 74 and 72, 75 if desired. Accordingly the office action erred to utilize a system characteristic of Spackova to support a "real action step" claim limitation of different nature. It is a fact that Spackova did not disclosed an "action step" to define several physical dimensional parameters. The office action failed to indicate where in Spackova this "action" step is disclosed.

When step (2) is considered, the examiner agreed that Spackova also did not explicitly disclose a step to measure the *m* parameters of the body (the examiner agreed that Spackova did not actually measure the distances between 72, 74 and 72, 75), however, the ground of rejection was based on the point that the system of Spackova allows the distances 72, 74 and 72, 75 to be measured if desired. Again, the office action erred

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to utilize a system characteristic of Spackova to support a real "action step" claim limitation of different nature.

When step (3) is considered, the office action could not indicate where in the disclosure of Spackova, the action of a "step" to processing said m values (distances between 72, 74 and 72, 75) to produce a multiple digits compressed BP code for representing said m values as claimed. The ground of rejection is based on the statement that the stored data for the composite image would result in a multi-digit code that represents the particular feature of the form fitting body if desired. **Again, the office action erred to utilize a system characteristic of Spackova to support a real "action step" claim limitation of different nature.**

For another example to demonstrate the problem caused by this type of rejection, the examiner is respectfully directed to the fact that a well equipped pharmacy factory is capable to produce many different types of medications. The current approach is equivalent to the ground of rejection of using a well equipped pharmacy factory, to reject different method claims of producing medications which required specific steps of using the facilities of the pharmacy factory to produce the medication. As a further example, since a generic computer can do a lot of jobs, the current approach of examination is equivalent to the erroneous point that many computer related patents issued should not be patented because the invented steps can be performed by a computer if desired.

If the ground of rejection is to be maintained, the examiner is respectfully requested to indicate where in Spackova, the real "act" of carrying out the claimed steps are disclosed, under the important point that system features is of completely different nature that cannot be used to reject method claims characterized with specifics of "steps" of action.

(B) Lack of motive

As the examiner acknowledged, it is a fact that Spackova lacks the "actual actions" claimed in the claimed limitations. The applicant believes the examiners may want to say that the system of Spackova teaches the claimed action steps. According to patent law, if a prior art teaches a claim characteristic, the prior art should disclose "motive" that

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lead to the claimed characteristics. This motive should be suggested by the prior art and not obtained by the examiner after reading the disclosure of the subject application. The factual point here is that the system of Spackova does not need the claimed limitations to perform its purpose – to build images for preview. The motive of Spackova to build her system is completely irrelevant to the subject claim limitations. If there is a motive for Spackova to define several physical measurement parameters, why Spackova did not define them, name them, measure them and code them in her disclosure. If the ground of rejection is based on the assumption that the system of Spackova "teaches" the three very special action steps claimed, the examiner is respectfully requested to provide evidence from the disclosure of Spackova that a motive was disclosed by Spackova for a person having ordinary skill in the art to do so.

(C) Analysis of prior art Aisaka

A new prior art Aisaka was introduced to support the teaching that the measured values of the physical dimensional parameters obtained from the teaching of Spackova can be compressed to form a single compressed BP code. The office made two references of Aisaka: Col 1, line 7-20, the introduction of size indicator 5, M etc as compressed BP Code of a garment; and Col. 1, line 60, the equipment can be used to measure the body of a wearer. Carefully analyzing the disclosure of Aisaka, the ground of rejection shows several critical defects as follow:

(a) Col 1, line 7-20 refers to wrong object of the subject claim:

The subject claims claimed a BP code of a "human body" while col 1, lines 7-20 of Aisaka refers to indicators of a "garment". While a garment from a manufacturer can be coded by indicators such as No. 5, No. 9, S, M, L as indicated by Aisaka, the measurements of human body cannot be represented by these indicators. As explicitly acknowledged by Aisaka in col 1, lines 14-18, a wearer may find his body fits S size of a first manufacturer, his body only fits M size of another manufacturer. **Lack of size standardization among different suppliers makes standard size indicators, such as S, M, L impossible to represent human body size codes as claimed.** Actually this is a problem mentioned by Aisaka and intended to be addressed by the invention of Aisaka.

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(b) The system of Aisaka CANNOT measure dimensional parameters of human body:

It seems col 1, line 60 of Aisaka disclosed that his equipment, when connected with a computer, can be used to automatically rate body forms and physique that represents a garment wearer. Aisaka did not say that his equipment can perform measurement of a human body as interpreted by the office action. In fact, the applicant studied the whole disclosure of Aisaka and could not understand how the equipment of Aisaka can be used to measure the parametric dimensions of a human body as claimed? This is really IMPOSSIBLE. The examiner is respectfully requested to explain how the equipment of Aisaka can perform human body measurement work as indicated in the office action, so as to support the ground of rejection?

(c) Number of digits for the code disclosed by Aisaka:

Aisaka only disclosed the size indicators of 5, 9, S, M, L in col 1, line 10-11 of his disclosure. All these indicators are NOT qualified as the body profile code claimed because they are all of single digit. Accordingly the referenced single digit indicators of Aisaka should be removed from the reference when examining the subject claims.

(d) Evaluation of Large as a multiple digits compressed code:

The office action indicated alternate size indicators such as Large etc. as examples of multiple digits BP code well known in the art. The examiner is respectfully directed to pay attention to the term "multiple digits compressed BP code" claimed. According to a person having ordinary knowledge in the art, only numbers can be characterized by the number of digits. This is why the question "How many characters are in the word Large?" is proper and the statement "How many digit are in the word Large?" is not proper. Accordingly the word Large is not a multiple "digits" code according to a person having ordinary knowledge in the art.

(e) Evaluating XL as a multiple digits compressed code:

The office action gave another example, the size indicator XL as a multiple digits compressed code. It is true that number codes may include alphabets. For example, as well known in computer technology, the hex number "1A" is equivalent to $16+10=26$ for decimal, or tenth basis. Under the theory of numeric system, every symbol used in a

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digit is a basic number element of a system. The basic elements of the tenth basis number system are 1, 2, 3,.....9 and 0. The basic elements for the Hex system are 1, 2, 3,.....9, A, B, C, D, E, F and 0. For a multiple digits code number, each digit is represented by one of the basic elements of the system. Now, if XS, XL are considered as a multiple digits code, it means the signs X, S and L are the elements of the corresponding number system. In that case the code can be formed by XL, it can also appears as LX, LS and SL according to this system. Obviously LX, LS and SL are not recognized in the art to identify size for garment. Therefore they do not belong to a system of "digits" as claimed. In fact, XL are not elements of a digit in a number system. They are merely signs or indicators that represent two words: X for Extra and L for Large. Accordingly XL is not a qualified multiple digits compressed code.

Listed below is a quotation of MPEP 2111.01 III:

"[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application."
Phillips v. AWH Corp., *415 F.3d 1303, 1313<, 75 USPQ2d 1321>, 1326<
(Fed. Cir. 2005) (en banc). *Sunracer Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)

The above discussion of the term "multiple digits" fully complies to the disclosure of the specification as well as to the understanding of a person having ordinary skill in the art. If the examiner has a different interpretation of the term "multiple digits", the examiner is courteously requested to clarify how this term is interpreted and to provide supporting evidence that this interpretation agrees with the principle of MPEP 2111.03 III.

(D) Rejection of claims 6, 7, 9-18 and 49:

The ground of rejection of claims 6, 7, 9-18 and 49 are supported by the statements provided on page 5, first paragraph of the office action can be divided into two parts as follow::

- (a) *Regarding claims 6, 7, 9-18 and 49, it would have been obvious to one of ordinary skill in the art at the time of the invention that the different data strings (n1 and n2 codes) could be used for a variety of applications (garment fitting, data manipulation, etc).*

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- (b) *In the examiners's view, the particular applications selected for the n1 and n2 data strings (e.g., size chart for fitting purposes, enhance resolutions, physical dimensional parameter, non-dimensional related information related to said human-body, out of range information of a parameter, etc.) would be a matter of design choice, and therefore, that limitation would not hold patentable weight.*

The second comment (b) of the office action:

The second comment of the examiner indicated that the BP code system of n1 and n2 data strings would be a matter of design choice, therefore the limitation would not hold patentable weight. According to the spirit of patent law, the way to determine if a limitation is purely a non-patentable design choice is to evaluate if the claim limitation serves a function, or if the claim limitation resolves a problem. If a function provided by the claim limitation, or if a problem addressed by the claim limitation is identified, then the claim limitation is **NOT** a purely non-patentable limitation. A typical example of design choice is changing the color of a patentable product from one color to another color is usually a matter of choice and therefore does not carry patentable weight. If the applicant is able to demonstrate that changing the color does provide functional effect to the product, such as adding reflective white color to a road sign for better visibility at night, then the claim limitation carries patentable weight. In the subject application, in a typical embodiment mentioned by the specification, the n1 code represents the basic BP Code system, which is obtained by compressing body parameter measurements. The n2 code provides additional information, which is not provided by the original n1 code, so as for the enhanced system to expand the servicing scope of the basic BP code system into additional territories. For example, claims 7, 14 and 49 allow the BP code of n1 to work with different existing size chart systems widely available in the market, a problem mentioned by Aisaka. Claims 11, 13 allow the basic BP Code system to service unusual body sizes such as the big and tall. Claims 12, 15 enhance the resolution of the basic BP code for special applications that requires high accuracy, such as high precision custom tailored services. Claims 10 and 16 enable the invented BP Code system to provide MIS information to the computing system of the garment retailer, which helps the retailer to provide better customer services. Once these additional functional services are identified, the enhanced n1+n2 BP code system mentioned in claims 6, 9, 17 and 18 provides additional features, which expands the servicing scope of the n1 only BP code

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system into other territories. Since additional functions of the n1+n2 system is identified, it is obvious that the n2 string adds patentable weight to the basic n1 only BP code system. If the examiner insists that the n1+n2 system are **PURELY** design choices that does not add functional or benefits to the basic n1 system, the examiner is respectfully requested to provide evidence why the above mentioned additional servicing functions provided by the n1+n2 system, as compared with the original n1 only system, does not add value to the original n1 only system?

The first comment (a) of the office action:

Comment (a) of the office action explicitly acknowledged that the n1+n2 systems are useful for various applications, but they are obvious. This is a contradiction to comment (b) of the office action the n1+n2 system is purely non-patentable design choices. This part of the office action explicitly acknowledged that the n1+n2 system is **NOT** a matter of choice that does not carry any weight to the claimed invention. The discussion below is based on the conclusion that the n1+n2 system did add value to the n1 only BP code system as acknowledged by the office action, and to evaluate if the limitations claimed are obvious according to a person having ordinary knowledge in the art.

Listed below is a quotation of a precedent court case *In re Sun*, 31 USPQ 2d 1451, 1455 (Fed. Cir. 1993),

Finally, appellants seemingly argue that the examiner's lack of citation to support the asserted level of skill in the art makes the rejections improper per se. This is so, appellants suggest, because without such citation, there is no record by which they can argue that the examiner erred.

The following is a quotation from 37 C.F.R. 1.107(b):

When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

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Accordingly, applicant courteously requested that if the rejection is maintained, the examiner either provides reference for each claim limitation as disclosed in a prior art, or alternately provides an affidavit under 37 C.F.R. 1.107 (b) providing citation regarding level of skill in the art and why it is appropriate to take the above statement of the office action (that the claim limitations added are obvious) to support the rejection of the additional limitations claimed by dependent claims 6, 7, 9-18 and 49.

(End of remark)